A

MEIDI-YA CO LTD, JAPAN & ANOR

v.

MEIDI (M) SDN BHD

B

FEDERAL COURT, PUTRAJAYA
ARIFIN ZAKARIA CJ (MALAYA)
AUGUSTINE PAUL FCJ
ZULKEFLI MAKINUDIN FCJ
[CIVIL APPEAL NO: 02-8-2007(W)]

C

4 DECEMBER 2008

CIVIL PROCEDURE: *Appeal - Appeal to Federal Court - Conditions of appeal - Appeal and cross-appeal pertaining to issue of registration of trade marks - Nature and manner in which questions ought to be framed*

D *for purpose of such appeal - Whether questions posed defective and need not be answered - Courts of Judicature Act 1964, s. 96(a)*

In this appeal and cross-appeal by the appellants and the respondent respectively pertaining to the determination of their

E rights regarding their applications for registration of their trade marks, the following questions required consideration in this appeal: (i) whether the use of the name and trade mark "Meidi-Ya" by the appellants in Malaysia entitled them to sole ownership of the said trade mark; (ii) whether the respondent ought in law

F to have been allowed to register Trade Mark Application No. 86/05265 comprising the trade mark "Meidi-Ya" in a stylised font in light of ss. 3, 10 and 14(1)(a) Trade Marks Act 1976 ('TMA') and the legislative intent of maintaining the purity of the Register of Trade Marks; (iii) whether having found that the appellants

G were entitled to register Trade Mark Application Nos. 87/05653, 87/05655, 87/05656, 87/05658, 87/05659 and 87/05661 comprising the trade marks "Meidi-Ya" and were thereby owners thereof in Malaysia, it was permissible in law to have allowed the respondent to register Trade Mark Application No. 86/05265

H which comprised the "Meidi-Ya" trade mark (albeit in a different font); (iv) whether in determining the ownership of a trade mark or the goodwill and reputation in a business as identified by a trade mark in Malaysia today, consideration solely of the international reputation and/or "spillover reputation and goodwill"

I of the appellants was sufficient; and (v) whether it was permissible under the law of passing off, for separate and independent parties to use a trade mark in Malaysia comprising an identical essential

feature and/or features which were confusingly similar in respect of the same description of goods in circumstances, when one had commenced use prior to the other and/or where there was a likelihood of confusion.

Held (dismissing the appeal and cross-appeal)
Per Augustine Paul FCJ delivering the judgment of the court:

(1) Question (i) in effect sought a reversal of the finding of fact made by the Court of Appeal and for this court to substitute it with its own finding of fact on the use of the trade mark by the appellants with the resultant consequential orders. This would result in a complete re-hearing of the appeal and would be a blatant disregard of s. 96(a) Courts of Judicature Act 1964 ('CJA'). The question posed must be so couched as to incorporate a point of law which had the effect of reversing findings that had been made without any further evaluation of the evidence. It was the answer to that question which must have the effect of reversing the finding on the first user made by the Court of Appeal and not the result of a review of the finding that had already been made. In addition, the question was based on an assumption that the appellants were the first users of the trade mark "Meidi-Ya". The question posed must relate to a matter in respect of which a determination had been made by the Court of Appeal as otherwise it would be academic. That was not the position here and, accordingly, the question was academic and did not come within the meaning of s. 96(a) CJA. Thus, it need not be answered. (para 8)

(2) Question (ii) suffered from the same defect as question (i). The Court of Appeal had found that the appellants had failed to show that they were the first users of the trade mark on or before 1986 and that the second appellant was incorporated only on 23 November 1987. Thus the second appellant, having been incorporated on 23 November 1987, was not even in existence when the respondent began to use its trade mark in late 1986. Accordingly, the Court of Appeal found no basis to deprive the respondent of its right to apply to have its trade mark in Application No. 86/05265 registered as it was the first user of the trade mark. In this question, as in the case of question (i), the appellants were attempting to reverse the findings of fact of the Court of Appeal by seeking

a review of them by this court. Therefore, this question also did not come within the meaning of s. 96(a) CJA and need not be answered. (para 9)

(3) Question (iii) as it stood was very general in nature. It basically sought to ascertain the legality of allowing the use by two entities of the same trade mark though with some difference. This could arise in various instances as illustrated, *inter alia*, by ss. 10, 14, 19 and 20 TMA. The generality of the language of the question imposed a burden on the court to ascertain the reason for which the same trade mark was allowed to be used by the two entities and decide on their legality. Alternatively, it required this court to ignore the reasoning of the Court of Appeal in having made the order and proceed on its own to make a decision afresh. The question ought to have been so worded that it was specific and precise to reflect the reason or ground upon which the orders were made by the Court of Appeal and the point of law involved which had the effect of invalidating the reason or ground. It was only then that the question could be said to be the basis of an appeal from the judgment or order of the Court of Appeal within the meaning of s. 96(a) CJA. In the circumstances, this question did not come within the scope of s. 96(a) CJA and it need not be answered. (para 10)

(4) The use of the word "... today ..." in question (iv) was significant. The appellants were quite obviously seeking to get a ruling from this court to extend the current changing trend in the law to Malaysia thereby ignoring *Lim Yew Sing v. Hummel International Sports & Leisure A/S*, which was followed by the Court of Appeal in this case. However, it had been held in applications for the registration of a trade mark, the rights of the parties were to be determined as at the date of the application. It followed that even if the answer to the question were in favour of the appellants it would be of no assistance to them. As the answer to the question would be only of academic value it need not be answered. (para 13)

(5) Question (v) was anchored on two trade marks which "... are confusingly similar ..." and/or "... where there is a likelihood of confusion". These were matters that have been assumed to be so for the purpose of the question. However, the finding of the Court of Appeal was that if the name "Meidi-Ya

FRESH BAKERY" was read and considered as a whole instead of just only the word "Meidi-Ya" the question of misrepresentation, confusion or deception should not arise. The question was therefore defective as it was based on an assumed state of affairs that was inconsistent with a specific finding of the Court of Appeal. It followed that question (v) did not come within the scope of s. 96(a) CJA and it need not be answered. (para 14)

(6) The conclusion was that all the questions posed were defective and need not be answered by this court. (para 15)

Bahasa Malaysia *Translation Of Headnotes*

Dalam rayuan dan rayuan balas ini oleh perayu dan responden masing-masing berhubungan dengan penentuan hak-hak mereka tentang permohonan mereka untuk pendaftaran cap dagang mereka, soalan-soalan berikut perlu dibicara dalam rayuan ini: (i) sama ada pengunaan nama dan cap dagang "Meidi-Ya" oleh perayu di Malaysia menyebabkan mereka berhak mendapat milikan tunggal cap dagang itu; (ii) sama ada responden sepatutnya dalam undang-undang dibenarkan mandaftarkan Permohonan Cap Dagang No. 86/05265 yang mengandungi cap dagang "Meidi-Ya" yang dalam suatu font berstail memandangkan ss. 3, 10 dan 14(1)(a) Akta Cap Dagang 1976 ('ACD') dan tujuan perundangan mengekalkan ketulenan Daftar Cap Dagang; (iii) sama ada setelah membuat keputusan bahawa perayu berhak untuk mendaftarkan Permohonan Cap Dagang Nos. 87/05653, 87/05655, 87/05656, 87/05658, 87/05659 and 87/05661 yang mengandungi cap dagang "Meidi-Ya" dan dengan itu merupakan pemiliknya di Malaysia, ia dibenarkan dalam undang-undang untuk membenarkan responden mendaftarkan Permohonan Cap Dagang No. 86/05265 yang mengandungi cap dagang "Meidi-Ya" (walaupun dalam font yang lain); (iv) sama ada dalam menentukan milikan cap dagang atau nama baik dan reputasi dalam sesuatu perniagaan yang dikenalpasti oleh sesuatu cap dagang di Malaysia hari ini, pertimbangan tentang hanya reputasi antarabangsa dan/atau "reputasi terlimpah dan nama baik" perayu ialah mencukupi; dan (v) sama ada ia dibenarkan di bawah undang-undang kelipuraan, untuk pihak-pihak yang berlainan dan berasingan untuk menggunakan cap dagang di Malaysia yang mengandungi sifat utama yang sama dan/atau sifat-sifat yang serupa mengelirukan berkaitan dengan gambaran yang

A sama dalam keadaan, apabila satu darinya telah mulakan penggunaan sebelum yang satu lagi dan/atau apabila terdapat kemungkinan kekeliruan berlaku.

Diputuskan (menolak rayuan dan rayuan balas)
B **Oleh Augustine Paul HMP menyampaikan penghakiman mahkamah:**

(1) Soalan (i) sebenarnya menuntut sesuatu pemansuhan dapatan fakta yang dibuat oleh Mahkamah Rayuan dan bagi mahkamah ini untuk menggantikannya dengan dapatan fakta sendirinya
C atas penggunaan cap dagang oleh perayu dengan perintah-perintah akibat langsung. Ini akan mengakibatkan sesuatu pendengaran semula rayuan dan akan menjadi suatu ketidakendahan yang berterang-terang s. 96(a) Akta Kehakiman
D Mahkamah 1964 ('AKM'). Soalan itu mesti dikemukakan supaya menggabungkan sesuatu perkara undang-undang yang mempunyai efek memansuhkan dapatan yang telah dibuat tanpa pertimbangan keterangan yang lebih lanjut. Ia
E merupakan jawapan kepada soalan itu yang mesti mempunyai efek memansuhkan dapatan mengenai pengguna pertama yang dibuat oleh Mahkamah Rayuan dan bukan keputusan pengkajian semula dapatan yang telahpun dibuat. Tambahan lagi, soalan itu berdasarkan sesuatu andaian bahawa perayu
F adalah pengguna pertama cap dagang "Meidi-Ya". Soalan yang dikemukakan mesti berhubung dengan perkara di mana suatu penentuan telah dibuat oleh Mahkamah Rayuan kerana jika tidak sebegitu ia merupakan hanya akademik. Itu bukan kedudukan di sini dan, oleh sebab itu, soalan itu ialah akademik dan tidak terangkum dalam maksud s. 96(a) AKM.
G Oleh itu, ia tidak perlu dijawab.

(2) Soalan (ii) mempunyai kecacatan yang sama seperti soalan (i). Mahkamah Rayuan telah membuat keputusan bahawa perayu telah gagal menunjukkan bahawa mereka merupakan pengguna pertama cap dagang pada atau sebelum 1986 dan bahawa
H perayu kedua hanya digabungkan pada 23 November 1987. Oleh itu perayu kedua, yang digabungkan pada 23 November 1987, tidak wujud pun apabila responden mula menggunakan cap dagangnya pada lewat tahun 1986. Oleh sebab itu,
I Mahkamah Rayuan tidak mempunyai apa-apa sebab untuk melucutkan hak responden untuk memohon cap dagangnya dalam Permohonan No. 86/05265 yang didaftarkan sebab ia

adalah pengguna pertama cap dagang itu. Dalam soalan ini, seperti dalam soalan (i), perayu cuba memansuhkan dapatan fakta yang dibuat oleh Mahkamah Rayuan dengan menuntut sesuatu pengkajian semula oleh mahkamah ini. Oleh itu, soalan ini juga tidak terangkum dalam maksud s. 96(a) AKM dan tidak perlu dijawab.

(3) Soalan (iii) seperti yang dikemukakan merupakan sangat umum. Ia pada asasnya menuntut kepastian tentang kesahan membenarkan penggunaan cap dagang yang sama walaupun dengan sedikit perbezaan oleh dua entiti. Ini boleh terjadi dalam beberapa keadaan seperti yang ditunjukkan, di antara lain, oleh ss. 10, 14, 19 dan 20 ACD. Keumuman mengenai bahasa soalan itu mengenakan suatu beban atas mahkamah untuk memastikan sebab yang membenarkan cap dagang yang sama digunakan oleh dua entiti dan membuat keputusan tentang kesahannya. Sebagai alternatif, ia memerlukan mahkamah ini untuk tidak mengendahkan pertimbangan Mahkamah Rayuan dalam membuat perintah itu dan dengan sendiri terus membuat suatu keputusan baru. Soalan itu sepatutnya dinyatakan dengan khusus dan tepat untuk menunjukkan sebab atau alasan yang mendorong Mahkamah Rayuan membuat perintah itu dan perkara undang-undang yang terlibat yang mempunyai efek membatalkan sebab atau alasan itu. Ia hanya bila ia menjadi begitu bahawa soalan itu boleh dikatakan menjadi asas sesuatu rayuan dari penghakiman atau perintah Mahkamah Rayuan dalam maksud s. 96(a) AKM. Dalam keadaan ini, soalan ini tidak terangkum dalam skop s. 96(a) AKM dan tidak perlu dijawab.

(4) Penggunaan perkataan-perkataan "… hari ini …" dalam soalan (iv) adalah penting. Perayu sememangnya jelas menuntut untuk mendapat suatu arahan dari mahkamah ini untuk melanjutkan trend semasa berubah-ubah dalam undang-undang kepada Malaysia dan dengan itu tidak mempedulikan *Lim Yew Sing v. Hummel International Sports & Leisure A/S*, yang telahpun diikuti oleh Mahkamah Rayuan dalam kes ini. Walau bagaimanapun, ia telah diputuskan dalam permohonan-permohonan untuk pendaftaran cap dagang, hak-hak pihak berkenaan harus ditentukan pada masa permohonan itu. Ini bermakna bahawa jikapun jawapan kepada soalan itu berpihak kepada perayu ia tidak membantu mereka. Oleh kerana jawapan kepada soalan itu hanya mempunyai kepentingan akademik ia tidak perlu dijawab.

(5) Soalan (v) terpaku atas dua cap dagang yang "... ialah serupa secara mengelirukan ..." dan/atau "... di mana terdapat kemungkinan kekeliruan berlaku". Ini merupakan perkara-perkara yang telah diandai bagi tujuan soalan itu. Akan tetapi, dapatan yang dibuat oleh Mahkamah Rayuan ialah bahawa jika nama "Meidi-Ya FRESH BAKERY" dibaca dan dipertimbangkan secara keseluruhan dan bukan hanya perkataan "Meidi-Ya" persoalan salah nyataan, kekeliruan atau perdayaan tidak patut berbangkit. Soalan itu, oleh itu, ialah cacat kerana ia berdasarkan halkeadaan andaian yang tidak konsisten dengan dapatan khusus Mahkamah Rayuan. Ini bermakna bahawa soalan (v) tidak terangkum dalam skop s. 96(a) AKM dan tidak perlu dijawab.

(6) Pada akhirnya semua soalan-soalan yang dikemukakan adalah cacat dan tidak perlu dijawab oleh mahkamah ini.

Case(s) referred to:

Baskin-Robbins Ice Cream Co v. Gutman & Anor [1976] FSR 545 ***(refd)***
JC Penney Co Inc v. Punjabi Nick [1979] FSR 26 ***(refd)***
Jellinek's Application [1946] 63 RPC 59 ***(refd)***
Joceline Tan Poh Choo & Ors v. V Muthusamy [2009] 1 CLJ 650 FC ***(refd)***
Lim Yew Sing v. Hummel International Sports & Leisure A/S [1996] 4 CLJ 784 CA ***(refd)***
Pioneer Hi-Bred Corn Co v. Hy-Line Chicks Pty Ltd [1979] RPC 410 ***(refd)***
Southern Cross Refrigerating Co v. Toowoomba Foundry Pty Ltd [1953] 91 CLR 592 ***(refd)***
Tan-Ichi Co Ltd v. Jancar Limited & Ors [1990] FSR 151 ***(refd)***

Legislation referred to:

Courts of Judicature Act 1964, s. 96(a)
Trade Marks Act 1976, ss. 3, 10, 14(1)(a), (d), 19(3), 70B

For the appellants - Dato' Ambiga Sreenevasan (Wee Choo Keong & Janini Rajeswaran with her); M/s Wee Choo Keong & Faaiz
For the respondent - SF Wong (S Indran & Chew Chui Yiang with him); M/s Shearn Delamore & Co

[Appeal from Court of Appeal, Civil Appeal No: W-02-563-98]

[Editor's note: For the Court of Appeal judgment, please see Meidi (M) Sdn Bhd v. Meidi-ya Co Ltd, Japan & Anor [2008] 1 CLJ 46.]

Reported by Suresh Nathan

JUDGMENT

Augustine Paul FCJ:

[1] This appeal highlights the nature and manner in which questions ought to be framed for the purpose of an appeal to this court pursuant to s. 96(a) of the Courts of Judicature Act 1964 ("s. 96(a)").

[2] The first plaintiff is a company established in Japan since 1885 and is involved in a variety of businesses which includes the manufacture and sale of various types of food like biscuits, cakes, pastries and other food products and liquor. The second plaintiff was incorporated in Malaysia on 23 November 1987 and is a subsidiary of the first plaintiff. The first defendant is a company based in Kuala Lumpur and is involved in, *inter alia*, the manufacture, sale and distribution of bread, cakes and other confectionaries since late 1986. The plaintiffs and the first defendant made separate applications to the Registrar of Trade Marks Malaysia for the registration of their trade marks. By its application bearing No. 86/05265 (exh. D47) dated 10 December 1986 the first defendant applied for the registration under Class 30 as its own a trade mark and trade name "Meidi-ya FRESH BAKERY" together with the logo showing stalks of wheat being blown in the wind with the word "Meidi-ya" in small letters and the words "FRESH BAKERY" in capital letters. On 24 November 1987 and 11 December 1987 the second plaintiff filed several application under different classes for the registration as its own of the trade mark 'MEIDI-YA'. It did not have the stalks of wheat and was in romanised alphabets as well as in Kanji characters. The relevant applications are those bearing Nos. 87/05653 under Class 29 (exh. 46A and P15), 87/05656 under Class 30 (exh. 46C), 87/05659 under Class 32 (exh. P13) and 87/05937 under Class 30 (exh. P17). In the case of No. 87/05937 (exh. P17) the trade mark applied for carried the words "MEIDI-YA FRESH BAKERY". The words are in capital letters with the words "FRESH BAKERY" added but without the stalks of wheat being blown in the wind.

[3] The Registrar of Trade Marks found the applications to be competing with each other. On 15 September 1992 he directed the parties under s. 19(3) of the Trade Marks Act 1976 ("the Act") to have their rights determined by the court. The claim of

the plaintiffs in the High Court was met with a counterclaim by the first defendant. Having heard both the parties the learned High Court Judge said in his judgment:

> The first defendant applied to the registrar of trade marks for the registration of the trade mark and logo as in exhibit D47. This was to have the trade mark and trade name "Meidi-ya Fresh Bakery" registered in its favour. Subsequently the second plaintiff applied for the registration of the trade mark and trade name "Meidi-ya" in romanised alphabets as well as in Kanji characters to be registered. Faced with these competiting applications, the registrar took the avenue out of his predicament which was provided under section 19 of the Trade Marks Act 1976 by referring this matter to court for determination.
>
> The trial of this case has been protracted owing to the number of witnesses involved as well as the fact that witnesses have come from Japan as well as from Singapore together with the fact that interpreters in the Japanese language have also had to be used. It is not my intention at this juncture to go into a detailed examination of the evidence that was adduced. However, I will in short state all findings of facts based on the evidence as analysed because of the different approaches taken in the presentation of the evidence by the parties.
>
> Having said that, it is my finding of fact that the first plaintiff has been a long user of the Meidi-ya trade mark and trade name together with the distinctive logo in the form of the Kanji characters, in Japan as well as in other parts of the world. It is also my finding of fact that the first defendant decided to open up its bakery and confectionery business in Malaysia and for this purpose it formed Meidi (M) Sdn Bhd. The business interests behind it is in the evidence. However, the history behind the formation and the adoption of the Meidi-ya trade mark and trade name by the first defendant is not accepted in the light of the evidence adduced. The court finds it difficult to accept the evidence of the first subscriber who said that he based his choice of the name Meidi-ya upon, and because of its resemblance to, his father's name. Unschooled and untrained as my ear is to the pronouncement of the name in question in its original form, it was obvious to me from hearing the witness with the name being enunciated in court that that name as enunciated was a far cry from the enunciation of Meidi-ya.
>
> Having said that, the question is what are the orders that the court should make in relation to the claim and counterclaim. It is also clear to the court that the plaintiffs took a considerable period of time in applying to have their trade mark and trade name

registered locally despite having become aware of what the first defendant had done. In the meantime the first defendant had expended sums of money and expanded its business. It has become a thriving business as a result.

In these circumstances and having regard to the ambit and operation of section 20 of the Trade Marks Act 1976, the court rules as follows in respect of the prayers sought by the plaintiffs in relation to their claim and by the first defendant in relation to its will, in toto, take the place of the prayers sought by the parties:

1. In relation to the plaintiffs' claim, subject to the declarations and order hereunder in respect of prayers (a), (b)(i) and (b)(ii)(A) in respect of the first defendant's counterclaim, there shall be:

(a) a declaration that the first defendant's application No 86/05265 for the registration of the trade mark as specifically reproduced therein shall not be registered as a trade mark as so reproduced as the use of it is likely to deceive or cause confusion to the public and is accordingly prohibited under section 14(a) of the Trade Marks Act 1976;

(b) a declaration that the second plaintiff's application Nos. 87/05653, 87/05655, 87/05656, 87/05658, 87/05659 and 87/05661 with the name and trade mark "MEIDI-YA" in romanised alphabets and in Kanji characters, and with the addition thereto of the distinctive Meidi-ya logo, belong to the plaintiffs, and that the plaintiffs, through the second plaintiff, are the lawful claimants entitled to file for registration of the said trade name, trade mark and logo under section 25 of the Trade Marks Act 1976;

(c) an order directed to the second defendant, the Registrar of the Trade Marks Malaysia, to forthwith proceed with the processing of the second plaintiff's application Nos. 87/05653, 87/05655, 87/05656, 87/05658, 87/05659 and 87/05661 and thereafter, subject to there being no formal opposition thereto and satisfaction of all other requirements and conditions for registration, to grant the second plaintiff the registration certificates therefore.

2. In relation to the first defendant's counterclaim, subject to the declarations and order in respect of the plaintiffs' claim, there shall be;

(a) a declaration that the second plaintiff's application No. 87/05937 for the registration of the trade mark as specifically reproduced therein shall not be registered as a trade mark as so reproduced as the use of it is likely to deceive or cause confusion to the public and is accordingly prohibited under section 14(a) of the Trade Marks Act 1976;

(b) a declaration that the name and trade mark "Meidi FRESH BAKERY" or, at the election of the first defendant, "Meidi (M) FRESH BAKERY" together with the logo/design depicting stalks of wheat being blown in the wind belong to the first defendant and that the first defendant is the lawful claimant entitled to file for registration of the said trade name and trade mark and companying logo/design under section 25 of the Trade Marks Act 1976;

(c) an order directed to the second defendant, the Registrar of Trade Marks Malaysia, to forthwith proceed with the processing of the first defendant's application No. 86/05265 as amended/modified above and thereafter, subject to there being no formal opposition thereto and satisfaction of all other requirements and conditions for registration, to grant the first defendant the registration certificate therefore.

3. Each party shall bear its own costs.

4. The parties shall be at liberty to apply to give effect to the declarations and orders made herein.

In substance therefore the High Court had allowed the registration of exh. D47 as the trade mark and trade name of the first defendant but with the stipulation that the word "Ya" after the word "Meidi" be not used. The addition of the words 'FRESH BAKERY" was allowed with the logo depicting stalks of wheat being blown in the wind. The second plaintiff was prohibited from registering exh. P17 which proposed the use of the words "MEIDI-YA FRESH BAKERY" as its trade mark.

[4] The first defendant appealed to the Court of Appeal while the plaintiffs cross-appealed. Richard Malanjum JCA (as he then was) in writing for the Court of Appeal said in his judgment:

27. Basically the core of the contention advanced before us for the 1st Defendant is that the 1st Defendant was the first in time to use the trade mark and trade name in Malaysia. It was submitted that the 1st Defendant started to use the trade mark and name as early as 1986 when the 2nd Plaintiff was not even incorporated. It was for the 2nd Plaintiff to

adduce evidence of its first to use the trade mark in Malaysia. The fact that the 1st Plaintiff might have used the same trade mark in Japan and elsewhere would not affect the application by the 1st Defendant as the Act is territorial in its application. The case of *Lim Yew Sing v. Hummel International Sports & Leisure A/S* [1996] 3 MLJ 7 was cited in support.

28. It was also submitted that since the 1st Defendant had the first use of the trade mark in Malaysia the Plaintiffs should not have the concurrent usage of the same trade mark. And being the first in filing for registration of trade mark as well as having the prior use of the trade mark the Malaysian public has associated it with the 1st Defendant. Usage by the 1st Defendant would not result in confusion and deception. What should be considered should be the mark only as reproduced without any Kanji character. Indeed the prior usage of the trade mark by the 1st Defendant entitled it to claim its proprietorship under section 25 of the Act. Meanwhile the Plaintiffs failed to adduce any cogent evidence of their use of the trade marks in relation to the goods of interest including bread and pastry in Malaysia before the use by the 1st Defendant in 1986.

...

31. The first learned counsel for the Plaintiffs agreed with the first user principle of law in trade mark dispute. However she submitted that the 1st Plaintiff is the rightful owner of the trade mark in issue and entitled to commence action for passing off. Notwithstanding, learned counsel conceded the need to show first user in Malaysia in order to succeed. Reference was then made that there was no challenge by the 1st Defendant to the evidential assertion by the Plaintiffs that the trade mark was already in use in Malaysia in 1982. Learned counsel insisted that the evidence showed of the availability of customers, small in number it might have been but sufficient in law, of the 1st Plaintiff in Malaysia even before 1986. The cases of *RH Macy & Co Inc v. Trade Accents* [1992] 1 SLR 581; *Compagnie General Des Eaux v. Compagnie Generale Des Eaux Sdn Bhd* [1993] 1 MLJ 55 were cited. And it was contended that to allow the application by the 1st Defendant would create confusion in the mind of customers since its proposed trade mark would not be distinguishable from that of the Plaintiff's.

...

A

36. In his oral ground of judgment the learned trial Judge found that the 1st Plaintiff was a long user of the Meidi-ya trade mark and trade name together with the distinctive logo in the form of Kanji characters in Japan and other parts of the world.

B

37. However, the learned trial Judge did not make any specific finding on the usage of the trade mark and trade name in Malaysia on or before 1986 although he had the advantage of hearing the various oral testimonies of witnesses called by both sides in addition to the documentary evidence produced before him.

C

38. Hence, the logical and reasonable conclusion is that he was not convinced with and declined to accept any of the evidence on the usage of the trade mark and trade name by the 1st Plaintiff in Malaysia on or before 1986.

D

39. In other words there was therefore no finding of first user of the trade mark and trade name by the Plaintiffs in Malaysia on or before 8.12.1986.

…

E

41. On our part and in view of the absence of specific and clear finding by the learned trial Judge on the first user issue we proceeded therefore to peruse the evidence made available to the learned trial Judge.

F

42. With respect, we are of the view that the Plaintiffs failed to show that it was the first user of the trade mark and trade name in Malaysia on or before 1986 (the material date). In the same way as probably the learned trial Judge was not convinced on the balance of probability of the evidence adduced by the Plaintiffs on first user claim we are equally not persuaded that the Plaintiffs had made out their case up to the standard of proof required. The fact that the same was used in Japan and in other parts of the world is immaterial for "trade mark law is very territorial in many aspects." (see: *Lim Yew Sing v. Hummel International Sports & Leisure A/S (supra)*.

G

H

…

45. Indeed from the evidence adduced it is not in dispute that the 2nd Plaintiff was only incorporated on 23.11.1987 which means that it was not even in existence when the 1st Defendant began to use its trade mark and trade name in late 1986. Further, it was not in contention that the 2nd Plaintiff was just the subsidiary of the 1st Plaintiff.

I

…

47. Accordingly for the foregoing reasons we find no basis to deprive the 1st Defendant of its right to apply to have its trade mark and trade name as reproduced in its application no. 86/05265 (exh. D47) it being the first user of such trade mark and trade name in Malaysia.

…

75. In the present case it is the contention of the Plaintiffs that the word 'Meidi-Ya' has been associated with the 1st Plaintiff for a long time. Hence, any use of the word would be likely to cause confusion and deception on their customers. However, in our view that may be right in Japan and elsewhere but not in Malaysia.

76. We would think that the term used by the 1st Defendant, namely, 'Meidi-Ya FRESH BAKERY' should be read and considered as a whole. If that is done the likelihood of confusion and deception should not arise. We find similarity in this case to that of the Canadian case where the Court did not find the necessity to continue the *ex-parte* injunction given to the plaintiff which used the words 'Kopy Kwik Printing' for its copying and duplicating business to restrain the defendant from using the words 'Kwik-Kopy Printing'. (See: *Ancona Printing Ltd v. Kwik-Kopy Corp* [1973] CPR (2d) 122).

77. Accordingly, we do not think the Plaintiffs have adduced sufficient evidence to establish the element of misrepresentation.

…

81. Hence, in respect of its claim for passing off against the Plaintiffs we find that not much evidence was adduced by the 1st Defendant on the essential elements to substantiate its claim. At any rate in view of our suggested approach to the trade mark and trade name of 'Meidi-Ya FRESH BAKERY' as used by the 1st Defendant, that is, to read and give effect to it as a whole instead of just and only the word 'Meidi-Ya', the question of misrepresentation, confusion or deception should not arise.

…

A

83. In conclusion we therefore say this. We allow the appeal by the 1st Defendant against the Order of the learned trial Judge prohibiting it from using exhibit D47 in exercise of its right to apply for registration of its trade mark and trade name pursuant to section 25 of the Act simply because the evidence adduced supported, on the balance of probability, the finding that it was the first user of the name 'Meidi-Ya FRESH BAKERY' with the logo of stalks of wheat being blown in the wind in Malaysia.

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84. And for the reason above we affirm the decision of the learned trial Judge to disallow the 2nd Plaintiff from using the trade mark and trade name as indicated in exhibit P17 when exercising its right to apply for registration under the Act.

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85. As regards the other applications of the Plaintiffs which the learned trial Judge allowed to be used we affirm that Order.

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86. We find no merit in the objection by the 1st Defendant for the 2nd Plaintiff to use such trade mark and trade name since it only involves the use of the word 'Meidi-Ya' without the word 'FRESH BAKERY' and the stalks of wheat being blown in the wind. Further, they are applied in different classes under the Act. Thus, in our view there are more than sufficient distinguishing features between the two trade marks and trade names.

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87. More so when the 1st Defendant is not using the Kanji character in its trade mark and trade name. We do not think deception and confusion as envisaged in section 19(3) of the Act could arise in this case.

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88. Accordingly we hereby order as we did when we made our decision on 28.10.2005.

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The orders made by the Court of Appeal are in the following terms:

A.

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1. In respect of the appeal vis-à-vis the Judgment we allow the appeal against the Order 1(a) in that it is set aside. We also allow the appeal against the Order 2(b) in that it is wholly deleted and substituted therefore with the following, to read:

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(b) a declaration that the name and trade mark "Meidi-Ya" together with the accompanying words "FRESH BAKERY" and the logo/design depicting stalks of wheat being blown in the wind as per the 1st Defendant's application No. 86/05265 belong to the 1st Defendant and that the 1st Defendant is the lawful claimant entitled to file for registration of the said trade name and trade mark and accompanying logo/design under Section 25 of the Trade Marks Act, 1976.

Accordingly we also allow the appeal against the Order 2(c) to the extent that the 1st Defendant's application No. 86/05265 is to remain unamended for consideration.

2. The 1st Defendant's appeal against Order 1(b) and (c) is dismissed. In effect we affirm order 1(b) and (c) except for a minor correction of the name and trade mark "Meidi-ya" to be written in bold capital letters as in the respective applications.

3. Order 2(a) is also affirmed.

B.

1. In respect of the cross-appeal by the Plaintiffs we dismiss it.

C. Each party is to pay its own costs here and below.

D. Deposits paid to be refunded to the respective parties.

Thus the Court of Appeal allowed application No. 86/05265 (exh. D47) by the first defendant to be considered for registration as its trade mark and trade name by the Registrar of Trade Marks without the modification as ordered by the High Court. The court agreed with the other orders made by the High Court except for a correction requiring the word 'MEIDI-YA" to be in capital letters.

[5] The plaintiffs (the appellants in this court) then applied for leave to appeal to this court pursuant to s. 96(a). The section reads as follows:

Subject to any rules regulating the proceedings of the Federal Court in respect of appeals from the Court of Appeal, an appeal shall lie from the Court of Appeal to the Federal Court with the leave of the Federal Court:

A (a) from any judgment or order of the Court of Appeal in respect of any civil cause or matter decided by the High Court in the exercise of its original jurisdiction involving a question of general principle decided for the first time or a question of importance upon which further argument and a decision of the Federal Court would be to public advantage.

B

It is perhaps necessary to refer to *Joceline Tan Poh Choo & Ors v. V Muthusamy* [2009] 1 CLJ 650 where this court in reviewing s. 96(a) said as follows:

C In commenting on the criteria to be satisfied in an application for leave to appeal under section 96(a) Edgar Joseph Jr FCJ said in *Datuk Syed Kechik bin Syed Mohamed & Anor v. The Board of Trustees of the Sabah Foundation & Ors* [1999] 1 MLJ 257 at p 265:

D To sum up, without prejudice to the generality of what we have thus far said, the Federal Court exercises its sensitive power to grant leave to appeal in civil cases sparingly and will not grant such leave unless both of the following criteria are satisfied by an intending appellant:

E (1) the judgment of the Court of Appeal has raised a point of general principle which the Federal Court has not previously decided or a point of importance upon which further argument and a decision of the Federal Court would be to public advantage; and

F (2) if the point is decided in favour of the intending appellant, there is a *prima facie* case for success in the appeal. (emphasis added)

It must be observed, and with respect, that the use of the words G "… which the Federal Court has not previously decided …" in criterion (1) may not be an accurate representation of section 96(a). An analysis of the section will make this clear. It contains two circumstances in which an appeal may be made to this Court. They are:

H *Limb (a)*

A question of general principle decided for the first time.

It is obvious that this is a reference to a decision of the Court of Appeal for the first time on a question of general principle. As I section 96(a) deals with appeals from the Court of Appeal to the Federal Court the word "… decided …" in section 96(a) refers

to a decision that has already been made. The use of the word in the past tense makes this manifestly patent. A decision that has been made can only be a reference to a decision of the Court of Appeal.

Limb (b)

A question of importance upon which further argument and a decision of the Federal Court would be to public advantage.

This limb is an unambiguous reference to an issue upon which there have been two or more previous decisions of the Court of Appeal. This is made clear by the purpose of limb (a) and the language of this limb itself. A reference to further argument and the fact that a decision of the Federal Court would be to public advantage has in contemplation two or more previous decisions of the Court of Appeal on the same issue which are, for example, in conflict or are wrong or made in ignorance of a binding precedent or made in following a decision of the Federal Court which is vague or wrong. Such a situation would create confusion to the public in the application of the legal principle involved to their affairs. In that event further argument and a decision of the Federal Court on the issue involved would be to public advantage as the confusion would be resolved.

It is thus clear that both limb (a) and limb (b) are separate and as they cater for two distinct circumstances they are mutually exclusive. It is now appropriate to consider the use of the words "…which the Federal Court has not previously decided …" referred to earlier in the passage from *Datuk Syed Kechik bin Syed Mohamed & Anor v. The Board of Trustees of the Sabah Foundation & Ors* [1999] 1 CLJ 325 in limb (a). It will be recalled that the reference in that limb to the decision made for the first time is to that of the Court of Appeal. It is true that the fact that the Federal Court has not previously decided on a point may mean that it is also the first time that the Court of Appeal has decided on the point as contemplated by limb (a). But, unfortunately, it can also mean that the Court of Appeal has decided on the point previously and that the Federal Court has not decided on it yet thereby making it a case upon which the Federal Court has not previously decided. It is clear by now that limb (b) becomes relevant only when there are two or more decisions of the Court of Appeal on a certain point. Thus the use of the words "…which the Federal Court has not previously decided …" in limb (a) in *Datuk Syed Kechik bin Syed Mohamed & Anor v. The Board of Trustees of the Sabah Foundation & Ors* [1999] 1 CLJ 325 will create confusion in the proper meaning to be accorded to both the

limbs. They ought to be replaced with the words "…decided by the Court of Appeal for the first time …" as contemplated by section 96(a). That will remove any confusion that may arise and, additionally, bring into proper focus the underlying distinction between both the limbs.

In an application for leave to appeal an intending appellant must identify the proper limb under which his case falls and address the arguments accordingly.

The next matter for consideration is whether the point if decided in favour of the intending appellant will show that there is a prima facie case for success in the appeal. This would depend on the issue to be raised in the appeal and, thus, on the nature and manner in which the question for appeal is framed. It must be so couched as to incorporate a point of law which has the effect of reversing findings made against the intending appellant without any further evaluation of the evidence. This in turn means that the answer given to the question must be such that it has the effect of reversing the judgment. It is only then that the question of success in the appeal can arise. It must be remembered that the very object of making appeals to this Court subject to leave is to prevent frivolous and needless appeals (see *Kredin Sdn Bhd v. OCBC Bank (M) Bhd* [1998] 2 CLJ 797). Leave to appeal on a proposed question will therefore not be granted if there is no hope of success (see *Beatrice a/p AT Fernandez v. Sistem Penerbangan Malaysia & Ors* [2005] 2 CLJ 713). This is logical. If the answer to the proposed question is obvious in the sense that it will not be in favour of the intending appellant there will be no basis for a prima facie case for success in the appeal. Where a decision depends on the application of a well-established principle to an individual set of facts, a further appeal to the Federal Court will be of no utility if it will do nothing to clarify or refine the principle, so as to make it applicable to other situations in the future (see *Datuk Syed Kechik bin Syed Mohamed & Anor v. The Board of Trustees of the Sabah Foundation & Ors* [1999] 1 CLJ 325). The question posed must relate to a matter in respect of which a determination has been made by the Court of Appeal as otherwise it will be academic (see *The Minister for Human Resources v. Thong Chin Yoong and another appeal* [2001] 3 CLJ 933 and *Raphael Pura v. Insas Bhd & Anor* [2003] 1 CLJ 61). It follows that a question cannot be based on an assumption that a finding has been made in respect of it when, as a matter of fact, no such finding has been made. However, a new point of law can be raised if all the facts necessary to support it have been raised in the Court of Appeal (see *Lim Geak Liang v. East West UMI Insurance Bhd* [1997] 4 CLJ 405). Needless to say, the

parties may by consent reframe or amend the question at the hearing stage of the appeal with the approval of the Court as demonstrated in *The Board of Trustees of the Sabah Foundation & Ors v. Datuk Syed Kechik bin Syed Mohamed & Anor* [2008] 3 CLJ 221.

The corollary is that if there is no prospect of success in the appeal the position of the appellant will not be affected and it would be pointless hearing the appeal. In *Sun Life Assurance Co of Canada v. Jervis* [1944] 1 All ER 469 Viscount Simon LC said at p 470:

> I do not think that it would be a proper exercise of the authority which this House possesses to hear appeals if it occupies time in this case in deciding an academic question, the answer to which cannot affect the respondent in any way. If the House undertook to do so, it would not be deciding an existing lis between the parties who are before it, but would merely be expressing its view on a legal conundrum which the appellant hopes to get decided in its favour without in any way affecting the position between the parties.

In *Loknath Padhan v. Birendra Kumar Sahu* AIR [1974] SC 505 Bhagwati J said at p 508:

> If an issue is purely academic in that its decision one way or the other would have no impact on the position of the parties it would be waste of public time and indeed not proper exercise of authority for the Court to engage itself in deciding it. … It would be clearly futile and meaningless for the Court to decide an academic question, the answer to which would not affect the position of one party or the other. The Court would not engage in a fruitless exercise. It would refuse to decide a question, unless it has a bearing on some right or liability in controversy between the parties. If the decision of a question would be wholly ineffectual so far as the parties are concerned, it would be not only unnecessary and pointless but also inexpedient to decide it and the Court would properly decline to do so.

Thus this Court has the power to decline to answer questions posed in appropriate instances in spite of the fact that leave to appeal had been granted with the result that the appeal must be dismissed without a consideration of its merits. This is demonstrated by cases such as *The Minister for Human Resources v. Thong Chin Yoong and Another Appeal* [2001] 3 CLJ 933, *Raphael Pura v. Insas Bhd & Anor* [2003] 1 CLJ 61, *Sri Kelangkota*

– *Rakan Engineering JV Sdn Bhd & Anor v. Arab-Malaysian Prima Realty Sdn Bhd & Ors* [2003] 3 CLJ 349, *Perwira Affin Bank Bhd v. Lim Ah Hee @ Sim Ah Hee* [2004] 2 CLJ 787 and *Tan Heng Chew & Ors v. Tan Kim Hor & Ors* [2006] 3 CLJ 481.

[6] The questions as reframed by the parties by consent for determination at the hearing of the appeal are as follows:

1. Whether the use of the name and trade mark "Meidi-Ya" by the appellants in Malaysia entitled them to sole ownership of the said trade mark.

2. Whether the respondent ought in law to have been allowed to register Trade Mark Application No. 86/05265 comprising the trade mark "Meidi-Ya" in a stylized font in light of ss. 3, 10 and 14(1)(a) of the Trade Marks Act 1976 and the legislative intent of maintaining the purity of the Register of Trade Marks.

3. Whether having found that the Appellants are entitled to register Trade Mark Application Nos. 87/05653, 87/05655, 87/05656, 87/05658, 87/05659 and 87/05661 comprising the trade marks "Meidi-Ya" and are thereby owners thereof in Malaysia, it is permissible in law to have allowed the respondent to register Trade Mark Application No. 86/05265 which comprises the "Meidi-Ya" trade mark (*albeit* in a different font).

4. Whether the respondent ought in law to have been allowed to register Trade Mark Application No. 86/05265 comprising the trade mark "Meidi-Ya" in a stylized font in light of s. 14(1)(d) and s. 70B of the Trade Marks Act 1976.

5. Whether in light of the legislative intent of maintaining the purity of the register, the name of the applicant in the second appellant's Trade Mark Applications may be substituted with the name of the first appellant, being the lawful proprietor of the trade marks "Meidi-Ya" in Malaysia and thus the rightful applicant and registrant.

6. Whether in determining the ownership of a trade mark or the goodwill and reputation in a business as identified by a trade mark in Malaysia today, consideration solely of the international reputation and/or "spillover reputation and goodwill" of the appellants is sufficient.

7. Whether it is permissible under the law of passing off, for two separate and independent parties to use a trade mark in Malaysia comprising an identical essential feature and/or features which are confusingly similar in respect of the same description of goods in circumstances, when one had commenced use prior to the other and/or where there is a likelihood of confusion.

The respondent cross-appealed and relied on question numbers 1, 2, 3, 6 and 7 as listed above.

[7] During the hearing of the appeal the appellants abandoned question numbers 4, 5 and 7. The remaining questions will now be considered.

Question No. 1

Whether The Use Of The Name And Trade Mark "Meidi-ya" By The Appellants In Malaysia Entitled Them To Sole Ownership Of The Said Trade Mark

[8] The Court of Appeal had made its finding of fact, after a review of the evidence adduced in the High Court and the submission of learned counsel on the concept of small use, that the appellants were not the first users of the trade mark "Meidi-Ya" in Malaysia. This is reflected in paras 31, 42, 45 and 47 of the judgment of the Court of Appeal reproduced earlier. As it is in apparent by now the determination that has been made is contrary to what is stated in the question. Thus this question and the submission advanced by learned counsel in support of it in effect seeks a reversal of the finding of fact made by the Court of Appeal and for this court to substitute it with its own finding of fact on the use of the trade mark by the appellants with the resultant consequential orders. This will result in a complete re-hearing of the appeal and will be a blatant disregard of s. 96(a). As stated earlier the question posed must be so couched as to incorporate a point of law which has the effect of reversing findings that had been made without any further evaluation of the evidence. It is the answer to that question which must have the effect of reversing the finding on first user made by the Court of Appeal and not the result of a review of the finding that had already been made. In addition, the question is based on an assumption that the appellants were the first users of the trade

mark "Meidi-Ya". The question posed must relate to a matter in respect of which a determination has been made by the Court of Appeal as otherwise it will be academic. That is not the position here. Accordingly, the question is academic and does not come within the meaning of s. 96(a). Thus it need not be answered.

Question No. 2

Whether The Respondent Ought In Law To Have Been Allowed To Register Trade Mark Application No. 86/05265 Comprising The Trade Mark "Meidi-ya" In A Stylized Font In Light Of ss. 3, 10, And 14(1)(A) Of The Trade Marks Act 1976 And The Legislative Intent Of Maintaining The Purity Of The Register Of Trade Marks

[9] This question suffers from the same defect as Question No. 1. The Court of Appeal had found that the appellants had failed to show that they were the first users of the trade mark on or before 1986 and that the second appellant was incorporated only on 23 November 1987. Thus the second appellant, having been incorporated on 23 November 1987, was not even in existence when the respondent began to use its trade mark in late 1986. Accordingly, the Court of Appeal found no basis to deprive the respondent of its right to apply to have its trade mark in Application No. 86/05265 (exh. D47) registered as it was the first user of the trade mark. See paras 40, 42, 45 and 47 of the judgment of the Court of Appeal reproduced earlier. In this question, as in the case of Question No. 1, the appellants are attempting to reverse the findings of fact of the Court of Appeal by seeking a review of them by this court. Thus, this question also does not come within the meaning of s. 96(a) and it need not be answered.

Question No. 3

Whether Having Found That The Appellants Are Entitled To Register Trade Mark Application Nos. 87/05653, 87/05655, 87/05656, 87/05658, 87/05659 And 87/05661 Comprising The Trade Marks "Meidi-ya" And Are Thereby Owners Thereof In Malaysia, It Is Permissible In Law To Have Allowed The Respondent To Register Trade Mark Application No. 86/05265 Which Comprises The "Meidi-ya" Trade Mark (Albeit In A Different Font)

[10] In order to appreciate this question it is necessary to be reminded of the facts of the case afresh. The Court of Appeal had found as a fact that the appellants had failed to establish that they

were the first users of the trade name at the material date. On the other hand it was held that the evidence adduced supported, on the balance of probability, the finding that it was the respondent who was the first user of the name "Meidi-Ya FRESH BAKERY" with the logo of stalks of wheat being blown in the wind. Accordingly, the learned High Court Judge's order disallowing the registration of Application No. 86/05265 (exh. D47) was reversed. It was for this reason that the decision of the learned High Court Judge to disallow the second appellant from using the name as indicated in Application No. 87/05937 (exh. P17) was affirmed. The other orders made by the learned High Court Judge in respect of Application Nos. 87/05653, 87/05655, 87/05656, 87/05658, 87/05659 and 87/05661 by the second appellant were also affirmed. The second appellant was allowed to use its trade name in these applications despite objections by the respondent since it only involved the use of the word "Meidi-Ya" without the word "FRESH BAKERY" and the logo of stalks of wheat being blown in the wind. It was held that there were more than sufficient distinguishing features between the two trade marks and trade names. See paras 76, 81, 83, 84, 85 and 86 of the judgment of the Court of Appeal reproduced earlier. It is obvious that the initial and first order made by the Court of Appeal was in respect of Application No. 86/05265 (exh. D47). The other orders made were in consequence of this order.

This question is so worded as to convey the impression that it is Application Nos. 87/05653, 87/05655, 87/05656, 87/05658, 87/05659 and 87/05661 which were approved first followed by Application No. 86/05265 (exh. D47). It is this difference in timing that forms the basis of the question. However, it is patent from the judgment of the Court of Appeal that it was Application No. 86/05265 (exh. D47) that was approved first based upon which the other orders were made. If the question is re-worded to reflect the correct sequence in which the orders were made the object of the question will be defeated. Thus the question as it stands does not flow from the judgment or order of the Court of Appeal and is therefore irregular. Be that as it may, the question as it stands is also very general in nature. Basically it seeks to ascertain the legality of allowing the use by two entities of the same trade mark though with some difference. This can arise in various instances as illustrated, *inter alia*, by ss. 10, 14, 19 and 20 of the Act. The generality of the language of the question imposes

a burden on the court to ascertain the reason for which the same trade mark was allowed to be used by the two entities and decide on their legality. Alternatively, it requires this court to ignore the reasoning of the Court of Appeal in having made the order and proceed on its own to make a decision afresh. The question ought to have been so worded that it is specific and precise to reflect the reason or ground upon which the orders were made by the Court of Appeal and the point of law involved which has the effect of invalidating the reason or ground. It is only then that the question can be said to be the basis of an appeal from the judgment or order of the Court of Appeal within the meaning of s. 96(a). In the circumstance this question does not come within the scope of s. 96(a) and it need not be answered.

Question No. 4

[11] This question has been withdrawn by both parties.

Question No. 5

[12] This question has been withdrawn by both parties.

Question No. 6

Whether In Determining The Ownership Of A Trade Mark Or The Goodwill And Reputation In A Business As Identified By A Trade Mark In Malaysia Today, Consideration Solely Of The International Reputation And/Or "Spillover Reputation And Goodwill" Of The Appellants Is Sufficient

[13] Learned counsel for the appellants submitted that there is an international spill over reputation and goodwill of the appellants' trade name into Malaysia and that it ought to have been taken into consideration by the Court of Appeal in determining whether the respondent could register its trade mark. Some Commonwealth jurisdictions have taken the view that it is not necessary to have a place of business and to have goods sold in a particular territory in order to enjoy reputation in the said territory which will be protected under the tort of passing off. (See, for example, *Tan-Ichi Co Ltd v. Jancar Limited and Others* [1990] FSR 151, *JC Penney Co Inc v. Punjabi Nick* [1979] FSR 26, *Baskin-Robbins Ice Cream Co v. Gutman & Anor* [1976] FSR 545 and *Pioneer Hi-Bred Corn Co v. Hy-Line Chicks Pty Ltd* [1979] RPC 410). Learned counsel for the respondent submitted that the issue is whether this

development in the law should be a recognised right in Malaysia. He referred to *Lim Yew Sing v. Hummel International Sports & Leisure A/S* [1996] 4 CLJ 784 where the Court of Appeal held that trade mark rights are territorial in nature and foreign use and goodwill would not be material to the consideration of rights in Malaysia. It is against this background that the language employed in the question requires careful scrutiny. The use of the word "… today …" in the question is significant. Quite obviously the appellants are seeking to get a ruling from this court to extend the current changing trend in the law to Malaysia thereby ignoring *Lim Yew Sing v. Hummel International Sports & Leisure A/S* [1996] 4 CLJ 784 which was followed by the Court of Appeal in this case. See para 42 of the judgment of the Court of Appeal reproduced earlier. However, it has been held that in applications for the registration of a trade mark, the rights of the parties are to be determined as at the date of the application (see *Southern Cross Refrigerating Co v. Toowoomba Foundry Pty Ltd* [1953] 91 CLR 592, *Jellinek's Application* [1946] 63 RPC 59 and *Pioneer Hi-Bred Corn Co v. Hy-Line Chicks Pty Ltd* [1979] RPC 410). It follows that even if the answer to the question is in favour of the appellants it would be of no assistance to them. As the answer to the question will be only of academic value it need not be answered.

Question No. 7

Whether It Is Permissible Under The Law Of Passing Off, For Two Separate And Independent Parties To Use A Trade Mark In Malaysia Comprising An Identical Essential Feature And/Or Features Which Are Confusingly Similar In Respect Of The Same Description Of Goods In Circumstances, When One Had Commenced Use Prior To The Other And/Or Where There Is A Likelihood Of Confusion

[14] This question is anchored on two trade marks which "… are confusingly similar …" and/or "… where there is a likelihood of confusion". These are matters that have been assumed to be so for the purpose of the question. However, the finding of the Court of Appeal is that if the name "Meidi-Ya FRESH BAKERY" is read and considered as a whole instead of just only the word "Meidi-Ya" the question of misrepresentation, confusion or deception should not arise. See paras 76 and 81 of the judgment of the Court of Appeal reproduced earlier. The question is therefore defective as it is based on an assumed state of affairs which is inconsistent with a specific finding of the Court of

A Appeal. As stated earlier the question posed must relate to a matter in respect of which a determination has been made as otherwise it will be academic. It follows that this question does not come within the scope of s. 96(a) and it need not be answered.

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[15] The conclusion is that all the questions posed are defective. They need not be answered by this Court. My learned brothers Arifin bin Zakaria CJM and Zulkefli bin Ahmad Makinudin FCJ have expressed their agreement with this judgment.

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[16] In the upshot the appeal and the cross-appeal are dismissed. Each party is to bear its own costs.

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